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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,455	11/26/2001	Donald L. Mobley	8266-0740	7793

7590 01/30/2002

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EXAMINER

BARTZ, CLIFFORD T

ART UNIT PAPER NUMBER

3613

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DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,455

Applicant(s)

MOBLEV ET AL.

Examiner

Clifford Bartz

Art Unit

3613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 6, 8 - 20 is/are rejected.
- 7) ☒ Claim(s) 7 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### Part III DETAILED ACTION

#### Continued Examination

This application is specified by applicant as a divisional of parent application 09/263,039. However, it has been treated as a continuation application since it has not been properly "carved out" of its parent ( the original claims have not been presented at the filing of this case, which is a requirement for filing a divisional ). Applicant is required to alter the specification to reflect the above.

#### Claim Rejections - 35 USC § 112 - 2

Claim(s) 11 - 20 is(are) rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For example, and as to parent claim 11: applicants claim in the preamble line 1 "a method for ... base frame...", and for example in places such as line 13; applicants then claim the welding of the mounting tube to the base frame.

It becomes unclear from the discrepancy in the preamble ( a method for ... base frame...- which is a statement of intended use ), and the positive connection of part of the device to a part of the base frame; whether applicant intends to claim the subcombination of just the device, or the combination of the device and the base frame.

Applicant could overcome this indefinite type rejection and particularly claim the subcombination, by inserting an appropriate phrase in all the necessary places: such as for example using the phrase -- adapted to be welded --; in place of the phrase "welding", in line 13. Parent claim 16 has a similar indefinite issue.

As to claim 15; this dependent claim does not limit the subject matter of its independent claim since it is not a step in the method.

The dependent claims are rejected under 35 USC 112 as incorporating the defects of the claims from which they depend.

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Claim Rejections - 35 USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 3, 5, 6, 9 is(are) rejected under 35 U.S.C. § 102(b) as being anticipated by Schultz ' 539 ( cited in the parent application ).

Schultz discloses base frame 12, including 22; patent support 20; sleeve 36; caster mounting tube 28 in Fig. 2; welds 55, located at opposite vertical ends of 54.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claim(s) 4, 10 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Schultz.

Schultz discloses all the structure of the claimed device as detailed above; except for particular aligned holes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided particular aligned holes, since applicant has not disclosed that the particular aligned holes solves any stated problem or is for any particular purpose and it appears the claimed invention would perform equally well without said holes.

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It would have been further obvious to one having ordinary skill in the art at the time the invention was made to utilize a rectangular cross-sectional shape, since it has been held to be within the general skill of a worker in the art to make a change in form or shape on the basis of its suitability for the intended use as a matter of obvious design choice. In re Dailey, 149 USPQ47( CCPA 1976 ).

Claim(s) 1, 2, 8 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Hall in view of Carlson ( both cited in the parent application ).

Hall discloses all the structure of the claimed device including: base frame 28, including 44; rectangular sleeve 54; rectangular mounting tubes 40; except for welds.

Carlson is relied upon merely to show that it is known in the art to provide welds 13.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the connection between the mounting tubes and the base frame utilizing welds as disclosed by Carlson, in order to provide immobility.

Claim(s) 11, 13, 14, 15 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Hilborn in view of Carlson ( both cited in the parent application ).

Hilborn discloses the method claimed in that Fig. 1 shows the base frame of a bed 14; mounting tube 12 with a generally round cross-sectional shape 34 ; except for welding.

Carlson is relied upon merely to show that it is known in the art to provide welds 13.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the connection between the mounting tube and the base frame utilizing welds as disclosed by Carlson, in order to provide at least vertical immobility. As to claim 13, the combination of Hilborn and Carlson discloses all the structure of the claimed device as

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detailed above; except for the particular step of configuring the interior opening as having a square cross-sectional shape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have configured the interior opening as having any particular shape, since this step is performed prior to the forming step, and thus essentially imbricates the forming step; and further: applicant has not disclosed that this particular “configuring” step solves any stated problem, or is for any particular purpose and; it appears the claimed invention would perform equally well without the “configuring” step.

Claim(s) 16, 19, 20 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Hilborn in view of Carlson (both cited in the parent application).

*ALL*  
Hilborn discloses the method claimed in that Fig. 3 shows the base frame of a bed 33; mounting tube 44 with a square cross-sectional shape 34; caster et al 40: except for welding.

*Fig*  
Carlson is relied upon merely to show that it is known in the art to provide welds 13.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the connection between the mounting tube and the base frame utilizing welds as disclosed by Carlson, in order to provide at least vertical immobility.

Claim(s) 17, 18 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Hilborn in view of Carlson (both cited in the parent application).

Hilborn discloses the method claimed in that Fig. 2, 3 shows the structure of the parent claim, except for a brake and locking mechanism. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a braking and locking mechanism for the caster; since the examiner takes Official Notice that braking and locking mechanisms used for casters are known in the brake art and it would be within the level

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of ordinary skill in the art for a routineer to combine a braking and locking means of this nature with Hilborn for positioning purposes. It is maintained that in such an arrangement as Hilborn, the contemplation of the use of brakes is well within the capability of a routineer in the art.

#### Allowable Subject Matter

Claim(s) 7, 12 would be considered allowable if rewritten to correct any objections; or overcome any applicable rejections, under 35 USC 112; and to include all the limitations of the base claim and any intervening claims.

#### Conclusion

In Schultz '495, note Fig. 5

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Bartz whose telephone number is (703)308 - 2564. The examiner can normally be reached on Mondays thru Fridays from 8:30 am to 3:30 pm.

( clifford.bartz@uspto.gov ) [ Fax -(703)308 - 3519 ]

If attempts to reach the examiner by telephone are unsuccessful; a message may be left at the Group Receptionist, whose telephone number is ( 703 ) 308 - 1113 .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson, can be reached on (703)308-2089


Any further inquiry of a general nature or relating to the status of this application may also be directed to the Group Receptionist, whose telephone number is ( 703 ) 308 - 1113.

Clifford T. Bartz  
Examiner  
Art Unit 3613 - 1/17/02

C 17B  
1/17/02

#### Summary:

Total claims	= 1 – 20
Rejected claims	= 1 – 6, 8 - 20
Objected claims	= 7, 12

  
PAUL N. DICKSON  
PRIMARY EXAMINER 1/25/02



